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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant/ : Nancy A. Abbe
Appellant

Application No. : 09/844,627 Confirmation No. : 2399

Filed : April 27, 2001

For : APPARATUS FOR STORING FOOD

Group Art Unit : 3727

Examiner : Stephen Castellano

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APPLICANT'S/APPELLANT'S REPLY
BRIEF UNDER 37 C.F.R. § 1.193(b)

Sir:

Pursuant to 37 C.F.R. § 1.193(b), applicant/appellant files this Reply Brief, in triplicate, in response to the Examiner's Answer dated April 29, 2004.

In view of the arguments and authorities set forth in the Appeal Brief and hereinbelow, this Board should find the rejections of claims 1-9, 13-17, 19-20, 24 and 26 of the above-

identified patent application to be in error and should reverse those rejections.

I. Arguments

In the Examiner's Answer, the Examiner continues a pattern of ignoring Applicant's arguments and of ignoring the relevant caselaw as it is applied to 35 U.S.C. §§ 102, 103 and 112.

The Examiner's Answer set forth numerous Grounds of Rejection, but addresses applicant's arguments in item 11 - Response to Argument. Applicant's reply will address each of the Examiner's rejections in the order they were made.

A. Examiner's General Comments

The Examiner's Answer begins with a completely unsubstantiated and unsupportable definition of "label." The Examiner states (for the first time during prosecution of this application) that a "label is not limited to a piece of paper with writing placed thereon but includes the contents of the container when viewable from the outside, therefore, ink, ice, business cards and bakery articles are all capable of labeling or identifying the contents of the container."

As a preliminary matter, the Examiner's stated purpose - labeling or identifying the contents of the container - is not at issue in any of the cited prior art. In fact, the only place that purpose is defined is in applicant's specification. As such, the Examiner's action is an impermissible application of hindsight reconstruction. *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) ("It is impermissible to use the claimed invention as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious.").

Moreover, the Examiner's definition of labeling is just plain wrong and ignores the plain meaning of the term. Webster's Ninth New Collegiate Dictionary's definition of label includes "a slip (as of paper or cloth) inscribed and affixed to something for identification or description." None of the definitions come even remotely close to the Examiner's proposed definition (see Webster's definition of "label" appended after the signature page of this Reply).

B. 112, First Paragraph

The Examiner's rejection under 35 U.S.C. § 112, first paragraph is based on applicant's use of the claim term "translucent." The Examiner has ignored: (1) applicant's arguments, (2) the MPEP, and (3) well established caselaw that clearly states that the applicant may be his or her own lexicographer. See MPEP, page 2100-48; *Multiform Desiccants Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998).

Applicant's specification clearly states that fabricating a portion of the outer wall out of a translucent material would allow users to easily read a label through the outer wall (applicant's specification, page 8, lines 13-18). Moreover, applicant's use of that term is consistent with one of the definitions in the dictionary cited by the Examiner (see Appendix D of Applicant's Appeal Brief), as well as Merriam Webster's Collegiate Dictionary, 10th Edition (see Appendix D of Applicant's Appeal Brief).

For at least the above reasons, the Examiner's rejection under 35 U.S.C. § 112, first paragraph, is clearly erroneous and should be reversed.

C. Rejections Under 35 U.S.C. 102(b)

The Examiner's rejections under 35 U.S.C. § 102(b) all appear to be missing the fundamental requirement of anticipation. In particular, each of the Examiner's rejections under 102(b) fail to show that all the elements of the invention, as expressed in the claims of the patent, be found in a single item of prior art. *C.R. Bard Inc. v. M3 Sys. Inc.*, 157 F.3d 1340, 1360-61, 48 USPQ2d 1225, 1239 (Fed. Cir. 1998). In each rejection, as set forth in detail below, the Examiner ignores one or more limitations of the claimed invention to achieve the anticipation rejection. Accordingly, each of the arguments set forth in this general section applies to each of the individual anticipation rejections discussed below. The Examiner's actions in this regard are clearly erroneous and should be reversed.

1. 102(b) Rejection: Oxley

The Examiner's rejection under 35 U.S.C. § 102(b) based on Oxley ignores at least two limitations of applicant's claimed invention. In one instance, the Examiner tries to explain away this deficiency - with regard to the limitation that the inner and outer walls have a fixed geometric

relationship - by arguing that walls E and F of Oxley "are fixed because they will not move in this configuration due to the friction fit of all the wall elements." This argument fails.

Oxley's walls E and F are never "fixed." Wall E is the front glass wall of the display case, while wall F is made of "stiff pasteboard" (Oxley, page 2, line 8-9). Wall F is removed at least on a daily basis to replace the baked goods that are on display in the front section of the device. In addition, wall F may be moved during the normal use of the display case since Oxley states that the remainder of the goods to be sold should be inserted loosely behind wall F. In that instance, it is likely that the merchant or the goods will make contact with one or both of the extensions G and move them (even slight movement is a violation of a "fixed" relationship). Thus, wall F is not in a fixed relationship with wall E.

Moreover, Oxley fails to provide the claimed limitation of a lid that can seal the container closed. Applicant's specification clearly states that the lid 50 "covers container 20 in an airtight seal to keep food fresh and

avoid freezer burn" (applicant's specification, page 11, paragraph [40])). Oxley does not teach or suggest that the display case is sealed in any way.

For at least the above reasons, the Examiner's rejection under 35 U.S.C. § 102(b) based on Oxley is clearly erroneous and should be reversed.

2. 102(b) Rejection: Morris 1 and Morris 2

The Examiner's rejection under 35 U.S.C. § 102(b) based on the Morris references ignores at least the same two limitations of applicant's claimed invention as was done with respect to the rejection based on Oxley.

In both Morris references, the apparatus shown and described is one which is assembled and disassembled on a regular basis, and one in which the "inner wall" comprises a series of individual support members 38 that are held in place once the device is assembled, by expandable tube 44. Like Oxley, all of the pieces of the "inner wall" are never in a fixed geometric relationship with the outer wall. If a customer bumps into the display stand while sitting down, there

is nothing to prevent even slight movement between the inner and outer walls. Thus, they are not fixed.

In addition, both of the Morris references are clearly lacking the claimed limitation of a lid that can seal the container closed. Applicant's specification clearly states that the lid 50 "covers container 20 in an airtight seal to keep food fresh and avoid freezer burn" (applicant's specification, page 11, paragraph [40]). Neither of the Morris references teaches or suggests that the display case is sealed in any way.

In addition, the Examiner argues that: (1) the term "food" only appears in the preamble and therefore, has no effect on the claims; and (2) that the Morris references show a food storage unit anyway, because there are locations to place salt, pepper and sugar. This argument also fails.

First, "if the claim preamble, when read in context of the entire claim, recites limitations of the claim, or, if the claim preamble is 'necessary to give life, meaning, and vitality' to the claim, then the claim preamble should be construed as if in the balance of the claim." *Pitney Bowes,*

Inc. v. Hewlett-Packard Co., 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999); see also MPEP 2111.02 (Effect of Preamble).

Second, as is clearly shown in both Morris references, the locations referred to by the Examiner are not for food storage. They are simply place to place food storage devices (if salt, pepper and sugar are assumed to be food). In that case, the food storage units would be the salt and pepper shakers and the individual packets of sugar.

For at least the above reasons, the Examiner's rejections under 35 U.S.C. § 102(b) based on either of the Morris references are clearly erroneous and should be reversed.

3. 102(b) Rejection: Pichereau

The Examiner's rejection under 35 U.S.C. § 102(b) based on Pichereau also ignores applicant's limitation of a lid that seals the container closed.

The Examiner argues that "Pichereau seals three out of four compartments." This argument fails for at least two reasons. First, there is nothing in Pichereau to suggest that any of the compartments are ever sealed. To the contrary,

Pichereau describes how the cover and sponge-cup are both made of glass, and that the cover can be moved about "with great ease" (Pichereau, page 2, lines 40-47) (if the cover were sealed with any of the chambers, the cover could not move about with great ease to open another chamber). Moreover, if Pichereau's ink stand were jarred, ink would clearly be spilled from each of the compartments, regardless of whether opening *f* were aligned with the compartment because there is simply nothing to keep the cover from lifting off the sponge-cup.

Second, the Examiner argues that the claims "don't require all compartments to be closed or sealed" is nonsense and ignores the actual text of the claim. As recited in claim 1, applicant's invention requires "a lid that may be fixably attached to said container top to seal said container CLOSED." Applicant notes that the word "closed" is in all capital letters and that it is the "container" that is closed, not part of the container.

Finally, the Examiner's argument that the "three peripheral chambers are capable of holding food" makes no sense because the food and the label would then be placed in the same chamber, which would render the label useless.

For at least the above reasons, the Examiner's rejections under 35 U.S.C. § 102(b) based on Pichereau is clearly erroneous and should be reversed.

D. Rejections under 35 U.S.C. § 103

In general, the Examiner's rejections under 35 U.S.C. § 103 are nothing more than impermissible hindsight reconstruction. What the Examiner has done in each instance is start with applicant's specification and claims and, using that as a template, searched for individual references to fulfill each claim element. In each rejection, the Examiner improperly combines two or more references without having the requisite motivation to do so. *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability - the essence of hindsight").

In each rejection, the Examiner takes basically unrelated references and combines them in a way that is not suggested by any of the references. In fact, the suggested combinations are counter to what a person of ordinary skill in

the art at the time of the invention what have done. In essence, during prosecution, the Examiner took each argument made by applicant, and went off to find a new reference that met the limitation at issue. However, "[o]bviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.... The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification...." *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (reversing the Examiner's affirmed obviousness rejection).

Moreover, for each rejection the Examiner has not rebutted applicant's argument related to long felt need, and thus, each rejection must be reversed on that basis alone. In each rejection under 35 U.S.C. § 103, the Examiner has relied on a reference that is at least 88 years old (and as old as 122 years). The age of these critical references is evidence of

secondary considerations that must be considered by the Examiner. *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966). In this case, however, that evidence was ignored. Accordingly, each of the arguments set forth in this general section applies to each of the individual obviousness rejections discussed below. The Examiner's actions in this regard are clearly erroneous and should be reversed.

1. 103(a) Rejection: Barhite in view of Dorney and Greiner

The rejection under 35 U.S.C. § 103 based on Barhite in view of Dorney and Greiner is improper and should be reversed for each and every reason described above in applicant's general section covering the rejections under 35 U.S.C. § 103.

Barhite is a 101 year old patent for a cream separator. The Examiner has attempted to invalidate applicant's claimed invention by combining Barhite with Dorney's Glow Cup System and Greiner's Decorative Container because "[i]t would have been obvious to modify the material of the outer wall of Barhite to be either translucent or transparent in order to see an item placed within the space

between the inner and outer walls of the container" (Examiner's Final Rejection, page 3).

This rejection violates the well established principles of obviousness law for several reasons. First, Barhite specifically discusses trying to minimize losses due to heat radiation, which is evidence that Barhite teaches away from the suggested combination. The Examiner improperly dismisses applicant's argument in this regard based on an unproven, unsubstantiated unrealistic analysis of the amount of heat needed to melt the ice used in Barhite. There simply is no evidentiary foundation on which to make this determination.

Second, there is no incentive or motivation to modify Barhite as suggested by the Examiner, other than to attempt to invalidate applicant's claims, because there is no need to see the ice inside the chamber (the Examiner admits that there is a substantial amount of ice used, suggesting that it would not melt before the cream was separated, so it irrelevant how much has melted).

Third, none of the cited references includes applicant's claimed label support member. Contrary to the

Examiner's new suggestion, stays 28 are described by Barhite as something that may be required as shown in FIG. 1. Fig. 1, however, simply shows a structural member that is used to maintain the separation between the outer wall of the milk receptacle and the outer wall of the ice chamber. There is no suggestion of a shelf large enough to hold a label or other device. In addition, as set forth in applicant's previous submission, Barhite teaches against using the chamber between the walls as a place to locate a label because that chamber is filled with ice and water. The Examiner continues to leave this point un rebutted as well.

For at least the above reasons, the Examiner's rejections under 35 U.S.C. § 103(a) based on Barhite, Dorney and Greiner is clearly erroneous and should be reversed.

2. 103(a) Rejection: Wooster in view of Dorney and Greiner

The Examiner's rejection under 35 U.S.C. § 103(a) based on Wooster in view of Dorney and Greiner fails for the same reasons as set forth above with respect to the obviousness rejection based on Barhite (which argument is incorporated by

reference, if necessary). For the convenience of the Board, that argument will not be repeated.

The Examiner's primary argument, however, is that "[t]here is absolutely no discussion of the criticality of heat radiation within Wooster" (Examiner's Answer, page 8). This argument makes no sense. The entirety of Wooster's invention is cooling warm milk so that cream separates from the milk. If heat radiation is allowed to enter Wooster's apparatus, its effectiveness is reduced thereby eviscerating Wooster's invention. In addition, like Barhite, there is no need to see the ice. Thus, there is simply no motivation of teaching to combine the references as suggested by the Examiner.

For at least the above reasons, the Examiner's rejections under 35 U.S.C. § 103(a) based on Wooster, Dorney and Greiner is clearly erroneous and should be reversed.

3. 103(a) Rejection: Oxley in view of Wooster

The Examiner's rejection under 35 U.S.C. § 103(a) based on Oxley in view of Wooster is also clearly erroneous and should be reversed.

The Examiner's suggested combination would take an "exceedingly cheap" (Oxley, page 2, line 22) device made of "stiff pasteboard" (Oxley, page 2, line 9) that can "be shipped in the flat" (Oxley, page 2, line 23) and turn it into a welded display case in which the merchant would lose one or two display shelves "since the direct connections such as welds and adjacent parts being formed as one piece do not make access as easy" (Examiner's Final Rejection, page 4). Applicant has great difficulty in understanding how the loss of easy access and the loss of display space would be incentive, teaching or motivation to make the suggested combination. In fact, the Examiner's own argument in support of invalidity is, instead, evidence of patentability.

The Examiner's proposed combination turns obviousness law on its head. The Examiner states that the motivation to modify Oxley into a welded apparatus is "a need to have parts that can't be disassembled easily" (Examiner's Final Rejection, page 4). This motivation does not exist in any of the references and is contrary to the basic principles of Oxley. One of the objects of Oxley's invention is a display case that "provide[s] such a means that will be readily removable and

which will permit new samples to be inserted" (Oxley, page 1, lines 36-42). That object would be eviscerated by the Examiner's proposed combination.

For at least the above reasons, the Examiner's rejections under 35 U.S.C. § 103(a) based on Oxley and Wooster is clearly erroneous and should be reversed.

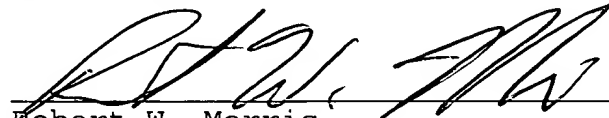
4. Other 103 Rejections

Applicant/appellant agrees with the Examiner that, if claims 1 and 26 are affirmed, all of the other rejections under 35 U.S.C. § 103 are moot.

II. Conclusion

For at least the above reasons, this Board should find the rejection of claims 1-9, 13-17, 19-20, 24 and 46 of the above-identified patent application to be in error and should reverse those rejections. Therefore, this application is in condition for allowance.

Respectfully submitted,



Robert W. Morris

Reg. No. 36,613

Attorney for

Applicant/Appellant

FISH & NEAVE

Customer No. 1473

1251 Avenue of the Americas

New York, New York 10020-1105

Tel.: (212) 596-9000

Fax: (212) 596-9090

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